

REMARKS

Claims 1, 2 and 4-18 are pending in this application. By this Amendment, claims 1, 5 and 14 are amended. No new matter is added.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments:

(a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration since the amendments amplify issues previously discussed throughout prosecution; and (c) place the application in better form for appeal, should an appeal be necessary. Entry of the amendments is thus respectfully requested.

I. Claim Rejection Under 35 U.S.C. §112

Claim 12 is rejected under 35 U.S.C. §112, first paragraph. The rejection is respectfully traversed.

The Office Action alleges that the specification fails to provide adequate written description for certain features recited in claim 12. The Office Action alleges that the originally filed specification only discloses that when automatic scanning features are enabled, the entire image (i.e., dimension) is scanned rather than only a portion of the image (page 9, lines 25-35).

The original specification provides ample support for automatically detecting dimensions as recited in claim 12. For example, at page 7, beginning on line 25, the specification recites that the image forming system 10 of the present invention scans the input document and determines where the actual image of the input image 58 resides in the input document 56 and that the specific portion of the input document 56 where the input image 58 resides forms the input image data and is the only portion that is reproduced on the subsequent output document 60. Furthermore, at page 8, beginning on line 9 of the specification, it is recited that the image multiplier feature of the present invention locates the

image in the original document and automatically scans the image portion of the document, creating the input image data relating to the image and not inclusive of the surrounding white space. The specification goes on to recite that the image multiplier feature then determines whether the input image can fit on the output paper the number of times instructed by the user. Accordingly, the specification specifically recites that the multiplier feature automatically scans the image portion of the document creating an input image relating to that image portion.

The specification goes on to distinguish manual or user manipulation of the multiplier feature from automatically scanning beginning at line 19 of page 8 of the specification which recites that the image multiplier feature additionally enables the user to manually indicate a portion of the input document 56 to scan and replicate. The specification points out that this alternative overrides the otherwise utilized ability of the image forming system to scan only the image or images on a document and not necessarily the entire document (see lines 24-26 of page 8). Accordingly, as the specification amply supports the subject matter of claim 12, withdrawal of the rejection of claim 12 under 35 U.S.C. §112, first paragraph, is respectfully requested.

II. Claim Rejections Under 35 U.S.C. §102

Claims 1, 2 and 4-18 are rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,144,452 to Abuyama. The rejection is respectfully traversed.

Abuyama fails to disclose each and every feature recited in the rejected claims, as amended. For example, Abuyama fails to disclose a method of forming an output image in an image forming system, comprising automatically determining a location of an original portion of an input document containing image data, instructing the system to duplicate the original portion of the input document, producing image data corresponding to only the original portion of the input document, forming a duplicate image of the original portion of the input

document, and reproducing the duplicate image a selected number of times on a printing medium, as recited in amended claim 1. Similarly, Abuyama fails to disclose automatically determining a location of an original portion of an input document containing image data, as recited in amended claim 5, or an image forming system comprising an image multiplier for automatically scanning an original image portion of a document and for automatically determining a number of times the image portion may be formed on a substrate, as recited in amended claim 14.

Abuyama relates to an image forming apparatus able to acknowledge to an operator the available number of duplicated image which the apparatus can produce on a given sheet (col. 1, lines 33-37). In Abuyama, a sheet of paper having a character image is placed on the platen glass too of an image formation device. The operator inputs (i.e., manual input) four coordinates X1, Y1, X2 and Y2 on the original image for designating a suitable image area including the character image, desired magnification rate and desired spaces through a control panel 80 (col. 7, lines 16-24; Figs. 4 and 5). Thus, in Abuyama, a great number of variables are required to be entered by the operator through a control panel to indicate a specific area on an original sheet that the user desires to have reproduced. In contrast, the subject matter of the amended claims relates to an automatic determination of the location of such an original portion. Accordingly, the apparatus of Abuyama is incapable of performing the features recited in the rejected method claims 1-13. Furthermore, Abuyama does not have an image multiplier feature as recited in apparatus claims 14-18 having the functionality recited therein. Accordingly, withdrawal of the rejection of claims 1, 2 and 4-18 under 35 U.S.C. §102(b) is respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 2 and 4-18 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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